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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,292	07/24/2003	Giovanni Rolando	SBC1003USC3	1865
9561	7590	06/14/2004	EXAMINER	
POPOVICH, WILES & O'CONNELL, PA			JACKSON, SUZETTE JAMIE	
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ART UNIT PAPER NUMBER				
3738				

DATE MAILED: 06/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/626,292	ROLANDO ET AL.
Examiner	Art Unit	
Suzette J Jackson	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 24 July 2003.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-7 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1.2 and 4-7 is/are rejected.

7)  Claim(s) 3 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.  
\_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Israel et al. 5,843,120. Israel et al. discloses the invention as claimed noting figure 2 comprising: a stent with first, second and third annular segments, each annular segment defining a substantially sinusoidal shape having a plurality of peaks and valleys, the second annular segment being positioned between the first and third annular segments, the first and third annular segments being in phase and the second annular segment 180° out of phase (see col. 3, lines 13-18) with the first and third annular segments such that the peaks of the first annular segment extend toward the second annular segment and are aligned longitudinally with the valleys of the second annular segment and the peaks of the third annular segment; first and second pluralities of bridge elements, the first annular segment being connected to the second annular segment by the first plurality of bridge elements and the second annular segment being connected to the third annular

segment by the second plurality of bridge elements, each bridge element of the first plurality of bridge elements being connected between a valley of the first annular segment and a longitudinally adjacent peak of the second annular segment and each bridge element of the second plurality of bridge elements being connected between a peak of the second annular segment and a longitudinally adjacent valley of the third annular segment. (see the marked-up color-coded enclosed for figure 2).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Israel et al. in view of Penn et al. 6,217,608. Israel et al. has been disclosed above however Israel et al. does not specify the use of Nitinol. Penn et al. teaches a stent with first, second and third sections made from nitinol (see col. 13, lines 42-49). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the stent of Israel et al out of Nitinol because this material is well known in the art for stents that are self-expanding and or easily maneuverable through curved vessel passages.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Israel. Israel et al. discloses the claimed invention except for a specific annular length of *about two millimeters*. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the annular segments "of about two millimeters", such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105USPQ 237 (CCPA 1955).

### ***Allowable Subject Matter***

6. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Penn et al. 6,217,608 ; Wijay 6,203,569 ; and Orth et al. 5,591,197 all show related material.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suzette J. Jackson whose work schedule is Monday-Friday 9-6:30 off every other Friday and whose telephone number is 703-308-6516.

9. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306.

10. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



Suzette J. Jackson

09 June 2004